

state and accommodating said dissemination during said [locking] unlocking state.

REMARKS

Claims 1 through 59 are pending in the application. Claims 5 and 56 are amended in various particulars.

In paragraph 1 of the Office action, the Examiner objected to claims 1 through 59 and stated that "A clean copy" is required showing the final disposition of the claims is required whereby claims 1-8 show with respect to the original patented claims . . . As to new claims 9-59 all text must be underlined once with no bracketing, except as above for the purposes of conveniently indicating changes from action to action in the marked-up copy."

The Examiner's attention is directed to the newly promulgated 37 C.F.R. §1.173(b)(2) which now governs making amendments to the claims in a reissue application. Per that section, presentation of "a clean copy" is not required. Accordingly, the objection to claims 1-59 should be withdrawn. However, for the Examiner's convenience, "a clean copy" of claims 1 through 59 is attached to this Amendment.

Claims 5, 6 and 56 through 58 were rejected under the second paragraph of 35 U.S.C. §112 on the Examiner's recognition of various typographic errors. Both errors have been corrected, and the basis for this rejection is removed. The Examiner's care in reviewing these

claims is noted with appreciation.

Claims 9 through 19, 29 through 39 and claims 40 through 58 were rejected under 35 U.S.C. §102(b) for alleged anticipation by or, in the alternative, under 35 U.S.C. §103(a) for alleged unpatentability over either Bonneau, U.S. Patent No. 4,510,623 or Amano, U.S. Patent No. 4,620,229. Applicant again respectfully traverses these rejections for the following reasons:

In support of this rejection, the Examiner now relies upon the decision of the Board of Patent Appeals and Interferences in the parent application. The Examiner's reliance is misplaced and misleading, because the Examiner ignores the express holdings of the Board, namely that (19) "After considering the contested limitations, we do no find a preponderance of evidence supporting a finding of anticipation under 35 U.S.C. §102(b) in view of Bonneau"; (27) "In light of the above findings, the preponderance of evidence does not support the findings of anticipation under 35 U.S.C. §102(b) in view of Amano"; and (13) "Thus, we cannot conclude that the subject matter of claim 8 would have been obvious in light of Bonneau or Amano." In short, the Board did not engage in an impermissible *point-of-novelty* determination of obviousness, the Board considered claim 8 in its entirety. Consequently, the Examiner's reliance upon the statements by the Board on specific limitations in the claims is misplaced.

Second, the decision of the Board was limited to claim 8; rejected claims 9 through 19 and 29 through 58 differ substantially in scope and content from claim 8. The decision of the

Board does not create some sort of estoppel that forbids Applicant from further presenting any claim that does not contain a verbatim recitation of all of the limitations of claim 8. Evidence of this is found in the fact that issued claims 1 through 7 were not before the Board of Appeals, but were in fact allowed by the Examiner prior to the decision by the Board. These claims differ in substance, text and scope from claim 8.

Bonneau '623, as was previously noted, teaches interference with and avoidance of any reception of the carrier frequency of a corresponding television broadcast signal. *See* Bonneau '623, column 1, lines 40-48 and column 2, lines 34-38. The Examiner's reliance upon Fig. 4A of Bonneau '623 is misplaced. The absence of correct frequency division in the phase locked loop of Bonneau '623 makes any reception, as well as any subsequent processing, of the blocked video signal simply impossible with Bonneau '623. Consequently, Bonneau '623 neither contemplates nor permits reception of the carrier frequency of a blocked channel. It is disingenuous to suggest therefore, that Bonneau '623 teaches muting of the carrier frequency signal of a blocked channel.

Amano '229 discloses a channel block that depends upon a remote control technique for either initiating particular programming functions or cycling between different operational modes and their corresponding four classes of different video displays provided to the television screen.

Amano '229 expressly teaches that the:

“Output of electronic tuning circuit 12, which is the output of phase locked loop 15, is supplied to tuner 1 to control the selection of the desired channel in a conventional manner” (column 4, lines 24-29).

In essence, no video signal is received on a “desired channel” unless control circuit 20 provides a control signal to decoder 13 which, in turn, drives channel selection voltage circuit 14 and phase locked loop 15. This is confirmed by Amano '229, which further expressly teaches that:

“Control circuit 20 also supplies control signals to decoder 13 of electronic tuning circuit 12 to control the channel selection and AC power source circuit 17 ...” (column 4, lines 59-62).

Amano '229, like Bonneau '623 does not receive blocked channels; consequently, both references lack Applicant's “video signal processor *receiving and processing* a first video signal”, as defined by line 9 of claims 9 and 15, as well as by line 9 of claims 29 and 35. Consequently, neither Bonneau '623 nor Amano '229 are able to receive, process and mute Applicant's video, or audio, signal as is required by the rejected claims. This, in combination with Applicant's muting circuit features, is neither taught nor suggested by either Amano '229 or Bonneau '623.

The Examiner now asserts that,

“In its decision in the parent application the Board stated that Bonneau et al. was different from the claims before it (and the present similar claims) in that Bonneau et al. did not teach “system power standby” or clearing the existing code each time. It did find

that displaying prompts and the key code on the screen to have been obvious."

The Examiner's reliance upon this mischaracterization of the Board's decision is misplaced, because the "present similar claims" are not identical to claim 8 that was before the Board, and it is somewhat difficult to understand the Examiner's fixation upon claim 8 that was the sole claim before the Board and that, despite the most vigorous arguments by the Examiner, was found by the Board to be patentably distinguishable and allowable over both Bonneau '623 and Amanno '229. Claim 8 is not similar to any of rejected claims 9 through 19 or 29 through 39. Moreover, the rejected claims are broader in scope than claim 8. It is respectfully suggested therefore, that the Board did not have the opportunity when examining allowed claim 8, also considering now pending claims 9 through 19 and 29 through 58, that the Examiner cease his efforts to somehow apply that the reasoning given by the Board to the rejected claims; it is the decision of the Board, rather than the reasoning of the Board, that constitutes a jural fact. Often, the reasoning is simply *obiter dictum*, and does not itself carry any legal effect.

The Examiner also asserts that,

"Thus, Applicant's argument for these claims on there being allegedly no reception of the carrier frequency is not tenable. The same argument was not supported by the Board in the original claims, since Bonneau et al.'s system includes circuitry that in some part must receive a signal that is rejected by the phase locked loop selectively."

This point was not at issue with claim 8 presented to the Board, and it is troubling that the Examiner has now asserted that the Board consider this point in its interpretation of Bonneau '623 and Amano '229. A thorough reading of the decision of the Board reveals that neither "tuning" nor "phase locked loop" appear in the decision. The Examiner's reliance upon the reasoning of the Board is consequently misplaced, and should be withdrawn.

Moreover, the Examiner's assertion that "Bonneau et al.'s system includes circuitry that in some part must receive a signal that is rejected by the phase locked loop selectivity" reveals a fundamental understanding of digital circuit design. Rather than repeat the careful description given by Bonneau '623 about how the "different channels of the television receiver can be tuned by varying the local oscillator frequency of the tuner," (*see* column 3, lines 35-38), it should be noted that the Abstract of Bonneau '623 simply states that:

Should a user input indicate one of the inhibited channels, the microprocessor does not load the corresponding programmable constant in the programmable frequency divider with the result that the television receiver continues to receive the last valid channel selected."

In short, the receiver of Bonneau '623 is constructed to not only not receive the inhibited channel, but is neither able to process the signal corresponding that inhibited channel nor to "mute" either the video or audio components of that corresponding signal, as required by the rejected claims. As noted by the decision of the Board, on page 15 of its reasoning, "although it would be simple

enough to modify Bonneau or Amano to operate that way, we see no motivation to do so ... thus, we cannot conclude that the subject matter of claim 8 would have been obvious in light of Bonneau or Amano.” Although the Board was addressing a different issue, its conclusion equally applies here where there is no motivation to modify Bonneau '623 to receive the video signal corresponding to a blocked channel; instead, Bonneau '623 simply continues to receive the video signal corresponding to the previous, unblocked channel and to display video images corresponding to that signal, rather than to practice Applicant's process. Consequently, the Examiner has failed to make a *prima facie* showing of obviousness, and the rejections must be withdrawn.

These distinctions are preserved in independent claim 15, which defines Applicant's step of receiving and processing a video signal, in independent claims 29 and 35 which define a video signal processor receiving and processing a video signal; and in process claims 44 and 48 that define steps of generating a video signal reproduced from a recording medium. Newly presented claims 55 and 56 respectively define reception of a video signal and reception of an audio signal. In contradistinction, the applied art never receives either the video signal or an audio signal due to the lack of digital tuning of the respective antennas. Separately, newly presented process claim 59 defines Applicant's novel process of checking for “a key data input signal received from a user during a system power standby mode of operation”. These features all readily distinguish Applicant's process and apparatus over the prior art.

It is this combination that advantageously enables Applicant's user to evaluate and selectively block video display of illicit or otherwise undesirable video material, regardless of whether that material has been received by a cable, television broadcast or replay from a DVD or magnetic tape. In view of these advantageous results flowing from this distinction, there is neither a *prima facie* showing of obviousness under §103 nor anticipation under §102. Accordingly, withdrawal of these rejections is required.

The Examiner seems to have fixated upon claim 8 and the decision of the Board as the decision addresses the issue of whether or not the system is locked. The Examiner's attention is directed to the fact however, that the Board found other distinctions between claim 8 and the applied art. For example, in paragraph 24 of the reasoning of the Board, the Board expressly found that "nothing in Amano suggest a step equivalent to Applicant's step of storing a new code if the system is not locked." Neither the doctrine of recapture nor the Bonneau nor Amano references prevent Applicant from advancing very broad claims directed to this feature in the instant application.

Sixteen of the Board's reasoning found different distinction with respect to the Bonneau '623 reference. Consequently, the Examiner's continued and repeated reliance upon these two references, and endeavors to rewrite the decision of the Board to apply to the rejected claims, is improper, and should be discontinued.

Claims 9 through 19 and 29 through 58 were newly rejected as being drawn to recaptured subject matter. The Examiner cited the *Pannu v. Storz Instrument, Inc.*, Fed. Cir. 00-1482, 7/25/2001 (decision). Applicant respectfully traverses this rejection for the following reasons:

The Pannu decision refers to U.S. Patent No. 4,436,855 (the Examiner's attention is drawn to the fact that the decision of the Court is incorrect, and that the Pannu '855 is actually U.S. Patent No. 4,435,855) and Re32,525. All claims in the '855 patent define the haptics as having "a continuous, substantially circular arc having a diameter greater than the diameter of the lens body," while claims 1 through 10 in the '525 reissue patent deleted this limitation. There were no claims in the '855 Pannu patent; consequently, *all* claims contain the same limitation. In view of the arguments presented by Pannu during prosecution of the '855 patent, the Court properly held that an attempt to obtain a broader definition of the haptics constituted a recapture of subject matter surrendered during the prosecution of the '855 patent.

A similar result may be found in *Hester Industries Inc. v. Stern Inc.*, 64 USPQ2d 1641 (Fed. Cir. 1998) where all of the original claims defined cooking "solely with steam" supplied by "two sources of steam", which limitations were deleted from the reissue patent. There, the Court properly held that the reissue patent was invalid.

In the instant application however, the Examiner has focused upon Applicant's "system power stand-by state" as defined by issued claim 8, and has asserted that the absence of this

limitation from the rejected claims constitutes impermissible recapture. The Examiner has ignored however, the fact that independent method claim 1 defines not the “system power stand-by state” of claim 8, but instead defines simply a “stand-by mode of operation” while independent apparatus claim 2 defines a “stand-by mode of operation.”

The rejected claims also define a “stand-by mode of operation” as opposed to the “system power stand-by state” of claim 8 argued by the Examiner. In view of the fact that claims 1 through 7 were not addressed by the Board of Patent Appeals and Interferences and were not the subject matter of the arguments presented by Applicant for patentability of claim 8, there is no basis for arguing recapture. Withdrawal of this rejection is therefore required.

Moreover, and most significantly, Applicant never argued non-obviousness before the Board of Appeals in the parent application. *See*, for paragraph 8 of the Board's findings, where the Board wrote “Curiously, Applicant does not challenge the examiner's rejection for obviousness in his brief.” The Board continued however, by finding that the Examiner simply had not met “the burden of establishing unpatentability by a preponderance of the evidence.” Absent challenge by Applicant then, there is no basis for the Examiner to now assert recapture. The rejections for recapture are unfounded on the record, and must be withdrawn.

In view of the foregoing explanations and remarks, all claims are deemed to be in condition for allowance. Should any questions remain unresolved however, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment.

Respectfully submitted,



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